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09/675,025	09/28/2000	Charles Eric Hunter	**OO-0140	7653
23377	7590	01/10/2008	EXAMINER	
WOODCOCK WASHBURN LLP			STRANGE, AARON N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.	Applicant(s)
	09/675,025	HUNTER ET AL.
	Examiner Aaron Strange	Art Unit 2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 October 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20071001</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

Response to Arguments

2. Applicant's arguments with respect to the rejection of claims 158-167, 175 and 176 have been fully considered but they are not persuasive.

3. With regard to claims 158-167, 175 and 176, and Applicant's assertion that in "the embodiment depicted in Figure 2", the mechanism includes hardware, it is noted that the *claims* contains no recitations limiting the subject matter to the embodiment described in Figure 2. Claims not limited to statutory embodiments are non-statutory. The Examiner recommends amending the claims to include positive recitations of hardware components where the claimed mechanisms are located.

4. Applicant's arguments with respect to the rejection of all pending claims under 35 U.S.C. § 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 158-167, 175 and 176 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. With regard to claims 158-167, 175 and 176, these claims merely recite "mechanisms" that may be implemented solely in software, and thus encompass software *per se*. The claims fail to define any structural or functional relationships between the mechanisms and other claimed elements, since the claims recite only mechanisms.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. In the interest of expedited prosecution, the Examiner would like to note that several of the present claims (i.e., 158, 175) use functional language to describe claim elements. For example, the term "configured to" raises questions as to the limiting effect of the functional language that follows it. The Examiner recommends amending the

system/device claims to contain positive recitations of the actions performed by the claim elements, rather than merely stating that the elements are "configured to" perform some future act. In the event that a hardware element is intended to contain software, which when executed, causes the hardware element to perform a function, the language of the claim should clearly express that relationship. Furthermore, claim 134, while a method claim, contains limitations such as "providing a mechanism" to perform a future act. This raises similar questions, since a mechanism may be "provided" without actually being used to do anything,

In the interest of expedited prosecution, all of these limitations have been rejected below, but Applicant is encouraged to amend the claims so that the claimed functions are positively recited, to ensure that those limitations may be given patentable weight.

10. Claims 134, 137-139, 141, 145-147, 149-51, 153, 157, 158, 160, 164-169, 171-173, 175, and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334) in view of Beach et al. (US 6,728,713).

11. With regard to claim 134, Walters discloses a method comprising:
transmitting a plurality of video programs to a plurality of consumer locations
(programs are transmitted to all subscriber locations)(col. 3, ll. 13-24);

transmitting classification information in a header of at least some of the plurality of video programs transmitted (all video programs contain a VID that uniquely identifies them)(col. 4, ll. 20-22);

providing a mechanism to compare the classification information to preference information of a consumer location (VID of received program is compared to ID of ordered programs)(col. 4, ll. 19-22; col. 11, ll. 39-49);

providing a mechanism to automatically select for storage in a storage medium at the consumer location video programs from the plurality of video programs having a defined degree of similarity between classification information and preference information (programs with a VID matching an ordered program are selected for storage)(col. 4, ll. 2-24); and

Walters fails to specifically disclose providing a mechanism to automatically overwrite stored digital data content with the automatically selected video programs according to a defined criteria.

Beach discloses a similar system for storing and playback of video programs at a client device based on user preferences. Beach teaches providing a mechanism to automatically overwrite stored digital data content with automatically selected video programs according to a defined criteria (newly downloaded programs replace previously stored programs based on various criteria)(col. 18, ll. 40-61). This would have been an advantageous addition to the system disclosed by Walters since it would have allowed a small storage area to appear much larger (Beach; col. 18, ll. 51-54) and

given the user immediate access to a variety of programs of interest to the user without waiting for them to be received.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically overwrite previously stored digital data content with newly selected programs since it would have given the user immediate access to programs of interest and allowed a smaller storage space to appear larger to the user.

12. With regard to claim 137, Beach further discloses that the defined criteria is that oldest stored video programs are overwritten with the automatically selected video programs (expired programs are overwritten)(col. 18, ll. 40-42 and 59-61).

13. With regard to claim 138, Beach further discloses that the defined criteria is that older releases of stored video programs are overwritten with the automatically selected video programs (newer versions replace older versions previously stored)(col. 7, ll. 11-18).

14. With regard to claim 139, Beach further discloses that the defined criteria is that stored digital data content which least fits a preference of the consumer location is overwritten with the automatically selected video programs (programs recorded based on inferred preferences lose all scheduling conflicts)(col. 18, ll. 54-57; col. 19, ll. 18-21).

15. With regard to claim 141, Walters further discloses encoding the transmitted video programs with data permitting playback only on a playback device with compatible decoder (programs must be decoded prior to playback)(col. 9, ll. 47-51).

16. With regard to claim 145, Walters further discloses that the act of transmitting a plurality of video programs is carried out by direct broadcast satellite transmission on multiple channels in compressed time format (col. 3, l. 41 to col. 4, l. 9).

17. Claims 146, 147, 149-151, 153, 157, 158, 160, 164-169, 171-173, 175 and 176 are rejected under the same rationale as claims 134, 137-139, 141 and 145, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

18. Claims 140, 152, 159 and 174 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334) in view of Beach et al. (US 6,728,713) further in view of Russo (US 6,025,868).

19. With regard to claim 140, while the system disclosed by Walters and Beach shows substantial features of the claimed invention (discussed above), it fails to disclose that the automatically selected video programs are recorded on a removable and portable storage medium.

Russo discloses a similar system for storing video programs for playback at a client device. Russo teaches recording the video programs on removable, portable storage mediums (i.e., discs, tapes, etc)(col. 4, ll. 15-25). This would have been an advantageous addition to the system disclosed by Walters and Beach since it would have allowed users to transport their recorded programs to other locations for subsequent playback.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record the video programs on removable, portable media to allow transport of the recorded programs.

20. Claims 152, 159 and 174 are rejected under the same rationale as claim 140, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

21. Claims 142-144, 154-156 and 161-163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334) in view of Beach et al. (US 6,728,713) further in view of Banker et al. (US 6,005,938) further in view of Gilhousen et al. (US 4,613,901).

22. With regard to claims 142 and 143, while Walters and Beach disclose a substantial portion of the claimed invention (discussed above), they fail to specifically

disclose that the transmitted video programs are encoded with time-based code keys A correlated with periodic time-based code keys B that are blanket transmitted to the plurality of consumer locations and time-based code keys C that are provided to consumer locations within the plurality of consumer locations that are in good standing, wherein a consumer can only view a video program if all three code keys have been received.

Banker discloses a similar system for distributing digital information to consumer locations via a network (col. 1, ll. 10-17). Banker teaches encoding video programs with time-based code keys A (time-based instance keys used for decoding program are transmitted in ECMs with the program)(col. 5, ll. 40-52; col. 6, l. 63 to col. 7, l. 8) that are correlated with time-based code keys C (session keys) that are provided to consumer locations within the plurality of consumer locations that are in good standing (session keys are provided as part of DEMM, and are time limited by information in AEMM)(col. 4, ll. 8-14, ll. 37-53) (See also col. 1, ll. 51-59). Use of these keys would have been an advantageous addition to the system disclosed by Walters since they would have prevented content from being viewed by consumers who have not paid for it.

Gilhousen discloses a similar system for distributing video programs to subscribers and protecting the programs from unauthorized viewing (col. 1, ll. 17-20). Gilhousen teaches blanket transmitting a periodic time-based code key B (channel key) (col. 22, ll. 18-21) to all consumer locations within a particular category, such as class or service or type of customer (col. 21, ll. 43-44). Gilhousen further discloses that these keys are correlated with keys used to encode the transmitted programs (channel key is

needed to produce working keys needed to decode the program)(col. 20, ll. 55-67).

Using a blanket transmitted key correlated with the keys used to encode the transmitted programs would have been an advantageous addition to the system taught by Walters and Banker since it would have allowed scrambling/encryption of video programs to be enabled/disabled on a channel by channel and program by program basis rather than a user by user basis (Gilhousen; col. 22, ll. 24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use time-based keys as taught by Banker and Gilhousen to protect the transmitted video content from unauthorized viewing by parties that did not pay for the content, while retaining the ability to permit a program to be viewed by all subscribers without communicating directly with each individual subscriber.

23. With regard to claim 144, Walters further discloses receiving video program playback information from a consumer location at a central controller system periodically (i.e., monthly billing information) (col. 12, ll. 21-29). Banker discloses that the time-based code keys C are provided to the consumer location periodically (col. 1, ll. 57-59). The combined teachings of Walters and Banker would have taught or reasonably suggested to one of ordinary skill in the art to collect the billing information at the same time as the time-based code keys C are collected, since this would have allowed the system to bill the consumer when the keys are updated, to ensure that the consumer's account remains in good standing.

24. Claims 154-156 and 161-163 are rejected under the same rationale as claims 142-144, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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